

122-130  
JAL

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Jerome H. Lemelson                      Art Unit : 3202  
Serial No. : 07/049,381                                      Examiner : Howell  
Filed : 5/13/87  
Title : Machine Tool System

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Assistant Commissioner for Patents  
Washington, D.C. 20231

**PETITION TO RESUME PATENT PROSECUTION**

AUG 06 1997

Dear Sir:

This petition seeks quite simple relief: It asks the Patent Office to examine a duly filed patent application.

**The Lemelson Applications**

This application is one of four copending applications that are all continuations of a common parent application, SN 06/251,656. Two of the applications (SN 07/126,319 and this one) contain, respectively, method and apparatus claims copied from two Williamson patents.<sup>1</sup> The remaining two applications (SN 07/636,415 and 07/636,414) contain, respectively, method and apparatus claims patentably distinct from each other and not copied from the Williamson patents.

The examiner of the Williamson patents entered restriction requirements between apparatus and method claims. Thus, this application copies claims from an apparatus case, while the 126,319 application copies claims from a *divisional* application filed under 35 U.S.C. § 121. A restriction requirement in the common parent application, SN 06/251,656, was entered between method and apparatus claims as well.

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<sup>1</sup> The Federal Circuit in 1995 affirmed a final judgment declaring the Williamson patents unenforceable for inequitable conduct in the PTO. Molins P.L.C. v. Textron, Inc., 48 F.3d 1172, 33 U.S.P.Q.2d 1823 (Fed. Cir. 1995).

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Eight years after Mr. Lemelson copied method claims from Williamson U.S. Patent 4,621,410, the PTO declared an interference (#103,740) with Lemelson's interference method case (SN 126,319) in March 1996. The examiner also allowed, and held non-interfering, additional claims in that method case.

However, over ten years after filing of this application, no interference has been declared.

### **The Filings by a Litigation Group**

Molins, a British company that originally owned the Williamson patents, assigned its rights in 1996 to a group formed by Ford Motor Company.<sup>2</sup> Ford is an infringer of numerous other Lemelson patents that are the subject of pending infringement litigation. Lemelson v. Ford Motor Co., CV-N-92-613 and CV-N-92-545, now pending in the United States District Court for the District of Nevada.

The Ford group obtained access to this application and the non-interfering method application pursuant to an agreed protective order entered in the interference proceedings. It has since taken aggressive action to interfere with the ex parte prosecution of those cases. The Ford group sought to intercede in ex parte prosecution to delay issuance of the '415 (non-interfering method) application in multiple inappropriate ways:

- Although conceding that no recognized motion exists for bringing another application into an interference (see Gerk v. Cottringer, 17 U.S.P.Q.2d 1615, 1616 (Bd. App. 1991) ("the EIC was correct in our view in concluding that neither § 1.633(c)(2) nor any other interference rule authorizes a party to add an opponent's application to an

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<sup>2</sup> This group, a Michigan limited liability company, known as the Patent Defense Group and headed by Ford's house patent counsel, Roger May, acquired the Williamson patents after the Federal Circuit held them unenforceable for inequitable conduct. Thus, Ford and its fellow infringers acquired the Williamson patents solely to block Lemelson from getting patents.

interference”), the Ford group has purportedly moved under Rule 642 to have the APJ add the application to the interference.<sup>3</sup> The APJ initially denied this request but later “sua sponte” (but in response to the Ford group’s request for reconsideration) changed the denial to a “deferral.”

- The Ford group filed a petition in the interference seeking waiver of the rule that no petition can be filed in interference before a party’s brief at final hearing (Rule 644(b)) and seeking exercise of supervisory jurisdiction to add the ‘415 application to the interference. The APJ denied this petition on the ground that the Ford group had made no showing sufficient to suspend or waive the rules.

- The Ford group alternatively captioned its petition in the ‘410 Patent and apparently filed it in that file history, too. The APJ denied that aspect of the relief, stating that the ‘410 Patent was already within his jurisdiction.

- The Ford group filed a protest in the ‘415 application, stating that the case should be determined by the Examiner to interfere with the unenforceable Williamson ‘410 Patent claims. This protest has not been decided because the file has not been released to the Examiner.

- The Ford patent lawyer, Roger May, who is not of record in the interference, sent a personal letter to Commissioner Lehman (contrary to the PTO Rules of Practice — see at least Rules 33(a) and Rules 181(d)/183), asking him to intercede personally to prevent Mr. Lemelson from receiving any patents. It is not known what, if any, action has been taken by the PTO as a result of this improper letter.

The Ford group has *not* sought to include *this application* in the pending method interference. To the contrary, in oral argument before the APJ, the Ford group’s attorneys disclaimed any intent to bring this application into the method interference.

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<sup>3</sup> The Rule 642 “motion” was identified as superseding another filing, a Rule 635 motion (#8) to add the application. The APJ denied the Rule 635 motion.

Given the PTO-imposed method-apparatus restriction requirement in the common parent SN 251,656 and in the Williamson patents, there is no room for a contrary argument.

The Ford group has instead agreed that this application should be included in an interference with the Williamson reexamination certificate B1-4,369,563. This is a reexamination certificate issued on the Williamson patent declared unenforceable for inequitable conduct that is not in the method interference. However, the Ford group believes that SN 636,414 should also be included in the apparatus interference. The Ford group also wishes to have a different person (other than Primary Examiner Howell) assigned to oversee examination of these files, namely the APJ handling the method interference.

Lemelson copied the Williamson apparatus claims ten years ago! The PTO is responsible for inexcusable delay in declaring that interference, now compounded by the inexcusable delay in failing to permit ex parte prosecution to proceed in apparatus applications that admittedly do not interfere with the method patent.

The Ford group has filed the following papers directed at to the '414 application: A petition in the interference, a protest in the application, and the unauthorized letter to the Commissioner, all like the ones directed at the '415 application. The APJ has not rendered any formal decision on the apparatus petition, but his reasons for denying the method petition — that there was no showing to suspend the rules — applies equally well to this case. The Examiner has not decided the protest in the '414 application because the file has not been released to him.

The only Ford group paper specifically directed to this application were papers seeking to stay the method interference until an apparatus interference was declared in this application. Those requests were also denied. Thus, the Ford group agrees that this application is ripe for consideration of interference.

In sum, the PTO has not granted a single one of the web of papers filed by the Ford group, in whole or in part. The APJ has denied, deferred, or declined to rule on all aspects of the various requests directed to him.

### **The APJ's "Borrowing" of the Files**

In three of his orders denying the Ford group's requests (attached), the APJ:

"[D]irected the Program and Resources Administrators of the Board of Patent Appeals and Interferences ('Board') to borrow from the patent examining group, and monitor the whereabouts of, Lemelson applications 07/126,319, 07/636,415, 07/636,414 and 07/049,381. Presently, all of those applications are located in my offices as the Board. Absent direction from the Commissioner of Patents and Trademarks or other lawful order, it is ORDERED that those cases remain in my offices and under my control until such time as any relevant preliminary motions are decided. Further actions in those applications will be determined, at least in part, by the decisions on Williamson #18."

The referenced "Williamson #18" is a preliminary motion filed by the Ford group in September 1996 to add to the method interference the additional method claims in SN 07/126,319 that the Examiner had held allowable and non-interfering. The Ford group has also argued that claims of the '415 non-interfering method application are "variants" of the non-interfering claims that are the subject of Williamson #18. However, all claims of the '415 application are *different* claims than those pending in the 126,319 case. These claims include additional limitations, which makes the decision as to whether to bring them into the interference a distinctly different question from whether to add the '319 allowed claims.

In any event, the mere pendency of Williamson #18 provides no justification for the APJ to "borrow" the files of a different divisional, namely this application, which contains apparatus claims that even the Ford group concedes are not properly allotted to the method interference and in which an interference should be declared.

The preliminary motions will not be decided before the end of 1997. The Ford group seeks far longer delay, asking that the decision on the preliminary motions be deferred to final hearing and that it be permitted to take extensive discovery before then. There is no prospect for an early decision on Williamson #18 (or any other preliminary motion). It may take years rather than months for these motions to be decided. The PTO cannot responsibly continue to hold the Lemelson non-interfering applications hostage to the Ford group's motions in other matters.

In denying an earlier attempt by the Ford group to stay prosecution of the non-involved applications, a different APJ stated in the same interference: "This Board has no jurisdiction over applications which are not involved in the interference." [Paper No. 13, p.3 n.1 (attached)] This is the correct rule, which the PTO has an absolute legal obligation to follow here.

Mr. Lemelson recently filed a request for reconsideration to the APJ, including pointing out the lack of connection between Williamson #18 and the apparatus files as well as the impropriety of "borrowing" the non-interfering method file. The APJ's response was that he was "not persuaded" because "it is important that inconsistent decisions in *inter partes* and *ex parte* proceedings be avoided." However, the APJ has made no comments indicating why it would be appropriate to borrow files from a different division or explaining how continued *ex parte* prosecution of a different, admittedly non-interfering application would result in "inconsistent decisions."

#### **This Petition Is a Proper One**

Although reference to certain filings and orders in the copending method interference is unavoidable, this petition is being filed in an application that is, or at least is supposed to be, under *ex parte* prosecution. The Primary Examiner has jurisdiction over this application. The Board does not (and has so agreed). The Commissioner has jurisdiction over both the Primary Examiner and the Board. The

APJ, in issuing his orders, recognized that he might receive "direction from the Commissioner of Patents and Trademarks or other lawful order" that would supersede his order.

By this petition, Mr. Lemelson does *not* seek supervisory review of the APJ's orders. That would be an inter partes request that Mr. Lemelson would file in the interference. Rather, Mr. Lemelson seeks a decision ordering the Primary Examiner to retrieve a case file over which he has jurisdiction (this one) and to conduct further examination under the rules and the MPEP. Such an order would supersede the APJ's order "borrowing" the files absent other "direction." This relief is appropriate in view of the Commissioner's supervisory authority over the Examiner. Rule 181(a)(3). Applicant has enclosed a check for \$130.00 and requests relief under Rule 182, in the alternative. The Petitions Office is the appropriate place for decision. MPEP 1002.02(b)(3), (15).

**The Rules and MPEP Specify the Proper Procedure to Follow**

This application is clearly under ex parte prosecution. Examination should be resumed immediately, with the goal of framing an interference, if warranted.

First, it is clear that the Board has no jurisdiction over this application. The Board has conceded that point, in Paper No. 13 of the interference. The application is not an "involved" one. Rules 611, 614, and 615. No motion, request, or other paper is even pending seeking to "involve" this application in the pending interference.

Second, the APJ has offered only the following as authority for "borrowing" the file: "Lemelson's objections to this course of action ignore my authority under 37 CFR § 1.610(e) to determine a proper course of conduct in this interference for any situation not specifically provided for." However, this rule has no bearing here. Holding this apparatus application by "borrowing" the file is not "determining a proper course of conduct in [the method] interference." It is an unauthorized suspension of ex parte

prosecution for a prolonged, indefinite period in an application that has already been the victim of inconceivable PTO delay.

Third, this is *emphatically not* a “situation not specifically provided for”:

- Under MPEP 1004, the Commissioner has delegated his authority to identify an interference to the Primary Examiner, personally, not to the Board. See also Rule 609 and MPEP 2309, 2309.01, 2309.02. The Primary Examiner has the duty to set up an apparatus interference as he deems appropriate.

- The following procedure is set out in the MPEP to handle situations like this one, where there is a non-interfering case and an interference case by the same inventor. MPEP 2315.01 (emphasis added) states:

“Where one of several applications of the same inventor or assignee which contain overlapping claims gets into an interference, *the prosecution of all the cases not in the interference should be carried as far as possible*, by treating as prior art the counts of the interference and by insisting on proper lines of division or distinction between the applications. In some instances, suspension of action by the Office cannot be avoided. See MPEP § 709.01.”

The referenced section, MPEP 709.01 (citations omitted), advises examiners how to handle such issues:

“Examiners should not consider *ex parte*, when raised by an applicant, questions which are pending before the Office in *inter partes* proceedings involving the same applicant.

“Because of this where one of several applications of the same inventor which contain overlapping claims gets into an interference it was formerly the practice to suspend action by the Office on the applications not in the interference . . . .



"However, the better practice would appear to be to reject claims in an application related to another application in interference over the counts of the interference and in the event said claims are not canceled in the outside application, prosecution of said application should be suspended pending the final determination of priority in the interference.

"If, on the other hand applicant wishes to prosecute the outside application, and presents good reasons in support, prosecution should be continued."

### **The File Should Be Released**

Mr. Lemelson copied certain claims from the Williamson reexamination certificate over a decade ago, on May 13, 1987. The PTO has never declared that interference or taken any action in that application since a pro forma office action on July 17, 1989, to which applicant responded in a few weeks.

Applicant filed a petition almost two years ago (September 1995) seeking to obtain prompt declaration of the interference. That petition was never decided.

Now, in an interference involving a different divisional, the APJ thinks that it is appropriate to "borrow" these apparatus files, which may well cause years of additional delay. There is no legal authority in the MPEP, the Rules of Practice, or the statute for the Board to "borrow" a file and thereby effectively stay action by the Primary Examiner with respect to that file. Indeed, the rules and MPEP suggest that suspending action "was formerly the practice" but "the better practice" now is to continue prosecution. See Gerk, 17 U.S.P.Q.2d at 1616 ("if the requirements of [a rule] could be avoided via ... the EIC's discretion under §1.610(e), then [that rule] would be rendered a nullity").

Mr. Lemelson is 74 years old. He is entitled to the Office's examination of this application. He is entitled to it promptly, preferably in his lifetime. Interference

proceedings take long enough — if an interference is to happen it should be started soon. There is simply no excuse for the Office to continue a decade-long delay.

The Office should not permit a litigation opponent (the Ford group) that has no business in ex parte prosecution (except as a protestor) to file an unending stream of papers that interfere with orderly ex parte prosecution. None of the Ford group's papers have been granted, yet somehow the Office has done exactly what the Ford group hoped to achieve by delaying examination of Mr. Lemelson's patent applications. The Petitions Office should follow the published rules — those applicable to *all* applicants — and release this application file to the Primary Examiner.

The '414 application and this application should be released to the examiner immediately for consideration of declaration of an interference and determination of which claims should be included therein. The Primary Examiner has the duty to set up the interference, if warranted, and decide whether to include the '414 application or not. That process should be continued. It should be continued immediately.

Applicant's attorney is available by telephone at any time to answer any questions regarding this matter or to expedite handling or assist the Office in any way deemed necessary.

Respectfully submitted,

JEROME H. LEMELSON  
by his attorney



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Louis J. Hoffman  
Reg. No. 38,918

Dated: August 5, 1997

LOUIS J. HOFFMAN, P.C.  
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(602) 948-3295

Certification

I hereby certify that this paper, with attached copies of orders and check for \$130.00, is being hand-delivered this 6<sup>th</sup> day of August, 1997, to the U.S. Patent and Trademark Office.

By: Molly Felker  
Name: Molly Felker

RECEIPT IS ACKNOWLEDGED OF a document entitled "Petition to Resume Patent Prosecution," with attached orders and check for \$130.00:



UNITED STATES DEPARTMENT OF COMMERCE  
Patent and Trademark Office  
Address: BOX INTERFERENCE  
COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231

Filed by: Vice Chief Judge Richard E. Schafer  
Telephone: (703) 308-9797  
Facsimile: (703) 308-7953

Paper No. 13

BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES  
(Chief Judge Bruce H. Stoner, Jr.)

DAVID T. N. WILLIAMSON

Junior Party,

v.

JEROME H. LEMELSON

Senior Party.

Patent Interference No. 103,740

DECISION ON WILLIAMSON'S PETITION NO. 1

Williamson, the junior party in this interference, has filed a petition under 37 C.F.R. §§ 1.644(a)(2) and 1.183. The Commissioner has delegated the authority to decide such petitions to the Chief Administrative Patent Judge. MPEP 1002.02(f). The decision on this petition has been redelegated to the undersigned. Id.

Williamson presents a laundry list of requests related to the conduct of this interference. For the reasons stated below Williamson's petition is dismissed. Accordingly, a response to the petition by senior party Lemelson is unnecessary and none will be considered.

Williamson requests the following relief:

1. That proceedings in this interference be suspended or stayed;
2. that Lemelson be ordered to maintain all claims currently in application 07/126,319;
3. that Lemelson be ordered to identify all his pending applications relating to automated production and flexible manufacturing technology;
4. suspension of ex parte prosecution in Lemelson pending applications relating to automated production and flexible manufacturing technology;
5. appointment of an expanded panel to hear the appeal in Lemelson application 07/899,353; and
6. an oral hearing on this petition.

Decision

Williamson's petition is dismissed.<sup>1</sup>

Analysis

Williamson's petitions under 37 C.F.R. § 1.644(a)(2) for the Commissioner to exercise supervisory authority over this interference. Section 1.644(b) provides that petitions under § 1.644(a)(2) "shall not be filed prior to the party's brief for final hearing . . . ." Accordingly, the petition is premature and

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<sup>1</sup> While I have dismissed the petition, some of the relief requested by Williamson could not be granted or is unnecessary. Thus, Williamson asks that Lemelson be ordered to maintain all claims currently in application 07/126,319. That application is currently within the jurisdiction of this board. Amendments to involved applications are ordinarily not given effect until the application is returned to the ex parte jurisdiction of the examiner.

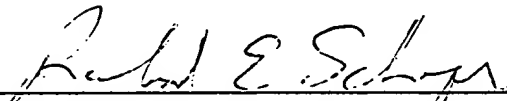
Williamson also requests suspension of the ex parte examination of certain Lemelson applications. This board has no jurisdiction over applications which are not involved in the interference.

The request for an expanded panel to hear an appeal in Lemelson application 07/899,353 is not possible because the appeal in that case has been heard and decided.

Williams also requests an oral hearing on this petition. Hearings on petitions and motions are discretionary with the APJ. In view of the dismissal of the petition on formal grounds, a hearing is unnecessary.

Interference No. 103,574

is not permitted under the rules. As to the request to suspend the rules under 37 C.F.R. § 1.183, Williamson has not identified a specific rule which is to be waived. It is not possible to determine whether this is an extraordinary situation in which justice requires waiver or whether the matter to be waived is a requirement of the rules or a requirement of statute. Accordingly, the petition is dismissed.

  
\_\_\_\_\_  
RICHARD E. SCHAFER  
Vice Chief Administrative Patent Judge

Interference No. 103,574

cc: Attorney for Williamson

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UNITED STATES DEPARTMENT OF COMMERCE  
Patent and Trademark Office  
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Washington, D.C. 20231

Filed by: Chief Judge Bruce H. Stoner, Jr.  
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Paper No. 120

BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES  
(Chief Judge Bruce H. Stoner, Jr.)

DAVID T. N. WILLIAMSON

Junior Party,<sup>1</sup>

v.

JEROME H. LEMELSON

Senior Party.<sup>2</sup>

MAILED

FEB 23 1997

PAT. & T.M. OFFICE  
BOARD OF PATENT APPEALS  
AND INTERFERENCES

Patent Interference No. 103,740

ORDER

Pursuant to 37 CFR § 1.635, Williamson has moved<sup>3</sup> for the following relief:

<sup>1</sup> Patent 4,621,410, issued November 11, 1986, based on Application 06/429,918, filed September 30, 1982.

<sup>2</sup> Application 07/126,319, filed November 10, 1987.

<sup>3</sup> WILLIAMSON MOTION UNDER 37 C.F.R. § 1.635 (No. 8), filed January 28, 1997, Paper No. 107 (Williamson Motion No. 8).

Interference No. 103,740

(1) redeclaration of Interference 103,740 by adding Lemelson Application 07/636,415 to the interference "and provisionally designating at least claim 186 thereof as corresponding to present Count 1, without prejudice to Williamson's right to file preliminary motions to redefine the interference,"

(2) suspension of the present preliminary motions schedule, and setting of a time within which Williamson, but not Lemelson, may file belated preliminary motions,

(3) suspension of prosecution of Lemelson Application 07/636,415 until the interference is terminated,

(4) expedited briefing on this motion, and,

(5) a scheduling conference with the Chief Administrative Patent Judge.

Simultaneously, Williamson has requested the same relief identified in points (1) and (3) above in a petition to the Commissioner filed January 28, 1997, in the present interference. In that petition, and in a separate letter dated January 29, 1997, signed by Roger L. May, Director and General Counsel, Patent Defense Group, L.L.C., an organization which I understand to be the present assignee of the Williamson patent, a request is made that a single official of the PTO be designated to coordinate and supervise prosecution of Lemelson applications 07/126,319, 07/636,415, 07/636,414 and 07/049,381, based on the relationship of the subject matter claimed therein to the subject matter forming the counts of the present interference.

Additionally, in the petition Williamson requests waiver of the prohibition of 37 CFR § 1.644(b) against petitions under 37 CFR § 1.644(a)(2) prior to the party's brief at final hearing.

Lemelson has opposed both the motion and the petition.<sup>4</sup>

On February 7, 1997, following several conference calls, I entered the following scheduling order:

SCHEDULING ORDER

The time periods previously set in the ORDER RELATING TO SCHEDULING AND MISCELLANEOUS MATTERS entered July 9, 1996, in the ORDER RELATING TO SCHEDULING entered August 1, 1996, and in the DECISION ON MOTIONS AND SCHEDULING ORDER entered November 6, 1996, are reset as follows [footnote omitted]:

TIME PERIOD NO. 2

The time for filing and serving:

(1) oppositions to preliminary motions (37 CFR § 1.638(a)) and (2) preliminary motions pursuant to 37 CFR § 1.633(i) and (j) responsive to a preliminary motion filed by an opponent (37 CFR § 1.636(b)) is set to expire on JUNE 27, 1997.

TIME PERIOD NO. 3

The time for filing and serving:

(1) replies to oppositions (37 CFR § 1.638(b)) and (2) oppositions to preliminary motions pursuant to 37 CFR § 1.633(i) and (j) is set to expire on AUGUST 27, 1997.

TIME PERIOD NO. 4

The time for filing replies to oppositions to preliminary motions pursuant to 37 CFR § 1.633(i) and (j) is set to expire on SEPTEMBER 26, 1997.

As stated in my original scheduling order, the parties are authorized to stipulate different

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<sup>4</sup>OPPOSITION TO WILLIAMSON'S RULE 635 MOTION #8 (SUSPENSION OF PROSECUTION OF COPENDING METHOD APPLICATION), filed February 18, 1997, Paper No. 116; OPPOSITION TO PDG'S PETITION REGARDING MR. LEMELSON'S COPENDING METHOD APPLICATION, filed February 18, 1997, Paper No. 119.

times (earlier or later) for TIME PERIOD NO. 2, provided, a written stipulation signed by counsel for both parties, including a proposed order shall be filed with the Board as soon as practical after any agreement is reached. The parties may not stipulate an extension of TIME PERIOD NO. 3 or TIME PERIOD NO. 4.

An exhibit mentioned in preliminary motions, oppositions, replies, and affidavits shall be served (but not filed) with the preliminary motion, opposition, reply or affidavit in which the exhibit is first mentioned, and all exhibits mentioned in preliminary motions, oppositions, replies and affidavits shall be filed simultaneously in the Patent and Trademark Office on or before SEPTEMBER 26, 1997.

HEARING ON PRELIMINARY MOTIONS

On or before OCTOBER 10, 1997, the parties shall file a paper indicating whether or not they desire oral argument on preliminary motions, it generally being my preference to have oral argument where there are contested preliminary motions.

A date for oral arguments on preliminary motions will likely be in the time period NOVEMBER 3, 1997, through NOVEMBER 14, 1997, to be set more precisely in a future order, preferably after a telephone conference call to be arranged in the future, it being my intention to decide preliminary motions within three (3) weeks of the date of any hearing.

Williamson Motion No. 8, to the limited extent that it requests the relief specified in points (2), (4) and (5), is DENIED. The preliminary motion schedule which existed at the time the motion was filed has been modified, following conference with me, as stated in my ORDER mailed February 7, 1997, and reiterated above. Lemelson's opposition to Williamson Motion No. 8 has also been filed.

Interference No. 103,740

I will, however, defer decision on the remainder of Williamson Motion No. 8. As the parties will recall, in footnote 3 of my ORDER mailed February 7, 1997, I stated:


there was an indication from both parties that LEMELSON'S RULE 635 MOTION #6 (REGARDING PERMISSION TO FILE LATE PRELIMINARY MOTIONS) filed November 7, 1996, Paper No. 93, and WILLIAMSON MOTION UNDER 37 C.F.R. § 1.635 (No. 7) filed December 23, 1996, Paper No. 101, were ready for decision. The parties were in disagreement as to WILLIAMSON MOTION UNDER 37 C.F.R. §§ 1.635 (No. 6), 1.616(a) AND 1.616(d), filed December 20, 1996, Paper No. 102. Williamson asks that decision on this motion be deferred, while Lemelson asks this motion be decided. I will endeavor to address these matters prior to the end of February 1997.

Circumstances beyond my control have prevented me from addressing these matters by February 28, 1997. For this I apologize to both parties. My calendar for March 1997 indicates that I might reasonably expect to take up the above-identified Williamson Motions No. 6 and 7, the remainder of Williamson Motion No. 8, and the above-identified Lemelson Motion #6 beginning about March 10, 1997. A decision may reasonably be expected about one month thereafter, that is, about April 10, 1997.

In order to preserve the status quo pending decision of that motion, and pending resolution of the petition and requests otherwise presented on behalf of Williamson, I have directed the Program and Resources Administrators of the Board of Patent Appeals and Interferences ("Board") to borrow Lemelson applications 07/126,319, 07/636,415, 07/636,414 and 07/049,381,

Interference No. 103,740

from the patent examining group. Presently, all of those applications are located in my offices at the Board. Absent direction from the Commissioner of Patents and Trademarks or other lawful order, it is ORDERED that those cases remain in my offices and under my control until such time as the motions are decided. Further actions in those applications will be determined, at least in part, by the decisions on the several motions identified above.

  
BRUCE H. STONER, JR.  
Chief Administrative Patent Judge

cc: Attorneys for Williamson

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MAILED

JUN 6 1997

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BOARD OF PATENT APPEALS  
AND INTERFERENCES



UNITED STATES DEPARTMENT OF COMMERCE

Patent and Trademark Office

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Washington, D.C. 20231

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Paper No. 149

BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES  
(Chief Judge Bruce H. Stoner, Jr.)

DAVID T. N. WILLIAMSON  
Junior Party,<sup>1</sup>

v.

JEROME H. LEMELSON  
Senior Party.<sup>2</sup>

Patent Interference No. 103,740

MEMORANDUM DECISION AND ORDER

On Tuesday, May 27, 1997, at about 2:30 pm (ET), a  
conference call was held involving the following participants:

Frank Osha, Esq., Mark Boland, Esq. and Kenneth J.  
Burchfiel, Esq. on behalf of Williamson;

Louis J. Hoffman, Esq. and Steven G. Lisa, Esq. on behalf of  
Lemelson, and

Chief Judge Bruce H. Stoner, Jr.

<sup>1</sup> Patent 4,621,410, issued November 11, 1986, based on  
Application 06/429,918, filed September 30, 1982.

<sup>2</sup> Application 07/126,319, filed November 10, 1987.

The conference call was scheduled at the request of counsel for Lemelson with the agreement of counsel for Williamson. Counsel for Lemelson sought from me an indication when a decision on motions might be expected. I indicated that a decision would be rendered no later than June 6, 1997, and indicated my availability for a conference call a week later, namely on June 13, 1997, in the event that discussion of alteration of the current schedule is required.

Before me for decision are the following:

(1) LEMELSON'S RULE 635 MOTION #6 (REGARDING PERMISSION TO FILE LATE PRELIMINARY MOTION) (herein "Lemelson #6")<sup>3</sup>.

Williamson has opposed<sup>4</sup> and Lemelson has replied.<sup>5</sup>

(2) WILLIAMSON MOTION UNDER 37 C.F.R. 1.635 (No. 7) ("Williamson # 7").<sup>6</sup> Lemelson has opposed<sup>7</sup> and Williamson has replied.<sup>8</sup>

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<sup>3</sup> Filed November 7, 1996 (Paper No. 93).

<sup>4</sup> WILLIAMSON OPPOSITION TO LEMELSON'S RULE 635 MOTION #6, filed November 26, 1996 (Paper No. 95) ("Williamson opposition #6").

<sup>5</sup> REPLY IN SUPPORT OF LEMELSON'S RULE 635 MOTION #6, filed December 11, 1996 (Paper No. 99) ("Lemelson reply #6").

<sup>6</sup> Filed December 23, 1996 (Paper No. 101).

<sup>7</sup> OPPOSITION TO WILLIAMSON'S RULE 635 MOTION #7 (LEMELSON'S REPLY BRIEF) filed January 13, 1997 (Paper No. 104) ("Lemelson opposition # 7").

<sup>8</sup> REPLY IN SUPPORT OF WILLIAMSON MOTION UNDER 37 C.F.R. 1.635 (No. 7), filed January 27, 1997 (Paper No. 106) ("Williamson reply #7").



(3) WILLIAMSON MOTION UNDER 37 C.F.R. § 1.635 (No. 8) ("Williamson #8").<sup>9</sup> In this motion, Williamson seeks the following relief:

(i) redeclaration of Interference 103,740 by adding Lemelson Application 07/636,415 to the interference "and provisionally designating at least claim 186 thereof as corresponding to present Count 1, without prejudice to Williamson's right to file preliminary motions to redefine the interference,"

(ii) suspension of the present preliminary motions schedule, and setting of a time within which Williamson, but not Lemelson, may file belated preliminary motions,

(iii) suspension of prosecution of Lemelson Application 07/636,415 until the interference is terminated,

(iv) expedited briefing on this motion, and,

(v) a scheduling conference with the Chief Administrative Patent Judge.

(4) WILLIAMSON PETITION TO THE COMMISSIONER REGARDING LEMELSON FMS METHOD APPLICATIONS ("petition") filed January 28, 1997, in both the present interference<sup>10</sup> and in Williamson Patent 4,621,410,<sup>11</sup> in which Williamson has requested the same relief identified in points (I) and (iii) above. In that petition, and

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<sup>9</sup> Filed January 28, 1997 (Paper No. 107).

<sup>10</sup> Attached to Paper No. 107.

<sup>11</sup> No paper number is presently available.

in a separate letter dated January 29, 1997, signed by Roger L. May, Director and General Counsel, Patent Defense Group, L.L.C., an organization which I understand to be the present assignee of the Williamson patent, a request is made that a single official of the PTO be designated to coordinate and supervise prosecution of Lemelson applications 07/126,319, 07/636,415, 07/636,414 and 07/049,381, based on the relationship of the subject matter claimed therein to the subject matter forming the counts of the present interference. Additionally, in the petition Williamson requests waiver of the prohibition of 37 CFR § 1.644(b) against petitions under 37 CFR § 1.644(a)(2) prior to the party's brief at final hearing.

Lemelson has opposed both the motion and the petition.<sup>12</sup> In my order entered February 28, 1997, I denied Williamson #8, to the limited extent that it requests the relief specified in points (ii), (iv) and (v).

(5) WILLIAMSON MOTION UNDER 37 C.F.R. §§ 1.642, 1.616, and 1.635 ("Williamson unnumbered motion").<sup>13</sup> In this motion, Williamson seeks to have me add Lemelson 07/636,415 to the present interference, to designate all Lemelson claims to

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<sup>12</sup> OPPOSITION TO WILLIAMSON'S RULE 635 MOTION #8 (SUSPENSION OF PROSECUTION OF COPENDING METHOD APPLICATION), filed February 18, 1997, Paper No. 116; OPPOSITION TO PDG'S PETITION REGARDING MR. LEMELSON'S COPENDING METHOD APPLICATION, filed February 18, 1997 (Paper No. 119).

<sup>13</sup> Filed March 5, 1997 (Paper No. 122).

correspond to the existing counts of this interference, and for sanctions against Lemelson. Lemelson has opposed.<sup>14</sup>

*Applicable Rules*

The following provisions of Title 37 of the Code of Federal Regulations are relevant to consideration of these motions and the petition. Regarding belatedly filed papers, 37 CFR § 1.645(b) provides:

(b) Any paper belatedly filed will not be considered except upon motion (§ 1.635) which shows good cause why the paper was not timely filed, or where an administrative patent judge or the Board, sua sponte, is of the opinion that it would be in the interest of justice to consider the paper.

Regarding matters not addressable by motions under 37 CFR § 1.633 (preliminary motions) or § 1.634 (correction of inventorship), 37 CFR § 1.635 provides:

A party seeking entry of an order relating to any matter other than a matter which may be raised under §§ 1.633 or 1.634 may file a motion requesting entry of the order. See § 1.637 (a) and (b).

Regarding the content of motions and the burden of proof, 37 CFR § 1.637 provides in relevant part:

(a) A party filing a motion has the burden of proof to show that it is entitled to the relief sought in the motion. Each motion shall include a statement of the precise relief requested, a statement of the material facts in support of the motion, in numbered paragraphs, and a full

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<sup>14</sup> OPPOSITION TO WILLIAMSON'S UNNUMBERED MOTION UNDER RULES 642, 616, AND 635 (PATENT DEFENSE GROUP'S ATTEMPT TO INTERFERE WITH LEMELSON'S EX PARTE PROSECUTION OF COPENDING, NON-INTERFERING APPLICATION), filed April 4, 1997 (Paper No. 136).

statement of the reasons why the relief requested should be granted. . . .

(b) Unless otherwise ordered by an administrative patent judge or the Board, a motion under § 1.635 shall contain a certificate by the moving party stating that the moving party has conferred with all opponents in an effort in good faith to resolve by agreement the issues raised by the motion. The certificate shall indicate whether any opponent plans to oppose the motion. The provisions of this paragraph do not apply to a motion to suppress evidence (§ 1.656(h)).

\* \* \*

(f) A preliminary motion for benefit under § 1.633(f) shall:

(1) Identify the earlier application.

(2) When the earlier application is an application filed in the United States, certify that a complete copy of the file of the earlier application, except for documents filed under § 1.131 or § 1.608, has been served on all opponents. When the earlier application is an application filed in a foreign country, certify that a copy of the application has been served on all opponents. If the earlier filed application is not in English, the requirements of § 1.647 must also be met.

(3) Show that the earlier application constitutes a constructive reduction to practice of each count.

Regarding the manner of proving material facts alleged in a motion, 37 CFR § 1.639 provides:

(a) Except as provided in paragraphs (c) through (g) of this section, proof of any material fact alleged in a motion, opposition, or reply must be filed and served with the motion, opposition, or reply unless the proof relied upon is part of the interference file or the file of any patent or application involved in the interference or any earlier application filed in the United States of which a party has been accorded or seeks to be accorded benefit.

(b) Proof may be in the form of patents, printed publications, and affidavits. The pages of any affidavits filed under this paragraph shall, to the extent possible, be given sequential

numbers, which shall also serve as the record page numbers for the affidavits in the event they are included in the party's record (§ 1.653). Any patents and printed publications submitted under this paragraph and any exhibits identified in affidavits submitted under this paragraph shall, to the extent possible, be given sequential exhibit numbers, which shall also serve as the exhibit numbers in the event the patents, printed publications and exhibits are filed with the party's record (§ 1.653).

(c) If a party believes that additional evidence in the form of testimony that is unavailable to the party is necessary to support or oppose a preliminary motion under § 1.633 or a motion to correct inventorship under § 1.634, the party shall describe the nature of any proposed testimony as specified in paragraphs (d) through (g) of this section. If the administrative patent judge finds that testimony is needed to decide the motion, the administrative patent judge may grant appropriate interlocutory relief and enter an order authorizing the taking of testimony and deferring a decision on the motion to final hearing.

(d) When additional evidence in the form of expert-witness testimony is needed in support of or opposition to a preliminary motion, the moving party or opponent should:

(1) Identify the person whom it expects to use as an expert;

(2) State the field in which the person is alleged to be an expert; and

(3) State:

(i) the subject matter on which the person is expected to testify;

(ii) the facts and opinions to which the person is expected to testify; and

(iii) a summary of the grounds and basis for each opinion.

(e) When additional evidence in the form of fact-witness testimony is necessary, state the facts to which the witness is expected to testify.

(f) If the opponent is to be called, or if evidence in the possession of the opponent is necessary, explain the evidence sought, what it will show, and why it is needed.

(g) When inter partes tests are expected to be performed, describe the tests stating what they will be expected to show.

Finally, regarding petitions in interferences, 37 CFR

§ 1.644 provides in part:

(a) There is no appeal to the Commissioner in an interference from a decision of an administrative patent judge or the Board. The Commissioner will not consider a petition in an interference unless:

\* \* \*

(2) The petition seeks to invoke the supervisory authority of the Commissioner and does not relate to the merits of priority of invention or patentability or the admissibility of evidence under the Federal Rules of Evidence;

(3) The petition seeks relief under § 1.183.

(b) A petition under paragraph (a)(1) of this section filed more than 15 days after the date of the decision of the administrative patent judge or the Board may be dismissed as untimely. A petition under paragraph (a)(2) of this section shall not be filed prior to the party's brief for final hearing (see § 1.656). Any petition under paragraph (a)(3) of this section shall be timely if it is filed simultaneously with a proper motion under §§ 1.633, 1.634, or 1.635 when granting the motion would require waiver of a rule. Any opposition to a petition under paragraphs (a)(1) or (a)(2) of this section shall be filed within 20 days of the date of service of the petition. Any opposition to a petition under paragraph (a)(3) of this section shall be filed within 20 days of the date of service of the petition or the date an opposition to the motion is due, whichever is earlier.

\* \* \*

(i) The Commissioner may delegate to appropriate Patent and Trademark Office employees the determination of petitions under this section.

*Lemelson #6 and Williamson #7*

In Lemelson #6, Lemelson seeks leave to file what he terms a "Proposed Preliminary Motion #6," a copy of which is attached to

Lemelson #6. The so-called "Proposed Preliminary Motion #6" seeks "benefit of an earlier effective filing date for all claims of all counts," that application being "Serial No. 712,433, filed March 12, 1968, which issued as U.S. Patent 3,559,256" (attachment to Lemelson #6, p. 1).

The sole reason given for the belated motion is said to be that "Mr. Lemelson's attorneys had believed that the Board had granted priority to that application already" (Lemelson #6, p. 1). The remainder of the motion elaborates on this mistaken belief, on amendments undertaken in application 07/126,319, and on similarities between a 1971 application, for which benefit has been accorded, and the 1968 application for which benefit is sought. Lemelson also lists a number of "reasons why counsel did not notice the omission" (Lemelson #6, pp. 4-5).

In opposition, Williamson (Williamson opposition #6, p.1) asserts that:

Lemelson has not satisfied his burden of establishing facts underlying the proposed excuse with any evidence whatsoever. Nary an affidavit accompanies the motion, which is merely premised on the unsupported allegations that some number of Lemelson's "attorneys" failed to notice that benefit was not initially granted with respect to the 1968 application. Even if Lemelson's excuse for the belatedness were not contradicted by the record, Lemelson's arguments for lack of prejudice to Williamson and excusable attorney negligence, are insufficient grounds for establishing "good cause" under prevailing legal standards.

In reply, lead counsel for Lemelson reiterates that the mistake was his, takes issue with Williamson's comments, and repeats his plea for granting the motion on the basis that this

is an extraordinary situation in which justice requires that the belated paper be considered.

Lemelson #6 is DENIED. Lemelson has failed to show good cause why the motion was not timely filed.<sup>15</sup> Lemelson's bald assertion of error, unaccompanied by any of the evidence mandated by 37 CFR § 1.639, is insufficient. In general, ignorance by a party or counsel of the provisions of the rules or of the substantive requirements of the law does not constitute "good cause" for failing to observe those provisions. See *Huston v. Ladner*, 973 F.3d 1564, 1566, 23 USPQ2d 1910, 1912-13 (Fed. Cir. 1992).

Belatedly presenting affidavits in a reply, as has Lemelson, is inappropriate under the circumstances here. As 37 CFR § 1.638(b) makes clear, "A reply shall be directed only to new points raised in the opposition." These affidavits are not in response to "new points raised in the opposition" but go to the very matter which Lemelson attempts to demonstrate in the motion itself. Accordingly, the affidavits will not be taken into consideration.

Williamson #7 is DISMISSED, the motion having been rendered moot by the decision to deny Lemelson #6.

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<sup>15</sup> Indeed, so far as I am aware, the motion has yet to be filed; Lemelson has filed a "proposed" motion.



*Williamson #8, Petition, and Williamson Unnumbered Motion*

In each of Williamson #8, the petition, and Williamson's unnumbered motion, counsel for Williamson has requested redeclaration of Interference 103,740 by adding Lemelson Application 07/636,415 to the interference. In Williamson #8 and the petition, Williamson asks that I "provisionally designat[e] at least claim 186 thereof as corresponding to present Count 1, without prejudice to Williamson's right to file preliminary motions to redefine the interference," or, as an alternative, order suspension of prosecution of Lemelson Application 07/636,415 until the interference is terminated. Certain other relief is sought in the petition, which will be addressed later. In Williamson's unnumbered motion, Williamson requests that all the claims of Lemelson 07/636,415 be designated as corresponding to the counts (pp. 28-138). Additionally, Williamson moves for sanctions against Lemelson (pp. 139-145).

Decisions on petitions under 37 CFR §§ 1.181, 1.182 and 1.183 relating to actions of the Board of Patent Appeals and Interferences or its personnel and under 37 CFR § 1.644 are consigned for decision to the Chief Administrative Patent Judge. See *Manual of Patent Examining Procedure* § 1002.02(f) (Sixth Edition, Rev. 2, 1996). In this particular instance, whether the issue is presented by motion, by petition pursuant to 37 CFR § 1.644 or by petition pursuant to 37 CFR §§ 1.181-1.183, the deciding official will be me.

In both Williamson #8 and the petition, Williamson has argued that (1) Lemelson claim 186 in Application 07/636,415 is derived from and claims essentially the same subject matter as does claim 38 in the involved Lemelson application 07/126,319 and (2) claim 186 defines the same patentable invention as does Williamson claim 234 which has been designated as corresponding to count 1 of the interference (Williamson #8, pp. 13-21; petition, pp. 16-24). Williamson's effort to have Lemelson's claim 186 designated as corresponding to count 1 of the interference amounts to an attempt to "short-circuit" the preliminary motion practice created by 37 CFR §§ 1.633, 1.637, and 1.638. Unsurprisingly, Williamson Preliminary Motion No. 18 (Williamson #18)<sup>16</sup> makes the argument that Lemelson claim 38 corresponds to count 1 of the interference. Lemelson's opposition to Williamson #18 is not yet due and does not yet appear to have been filed. Similarly, Williamson's attempt to have all of the claims of Lemelson 07/636,415 designated as corresponding to the several counts of this interference is yet another, albeit more detailed, attempt to "short-circuit" the preliminary motion practice created by 37 CFR §§ 1.633, 1.637, and 1.638. It is again worth noting that 37 CFR § 1.645 provides that, "A party seeking entry of an order relating to any matter *other than a matter which may be raised under §§ 1.633 or 1.634*

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<sup>16</sup> Filed September 26, 1996 (Paper No. 59).

may file a motion requesting entry of the order" (*italics for emphasis added*).

The alternative forms of relief which Williamson seeks by motion (that is, to redefine in Williamson #8 and Williamson's unnumbered motion or to suspend prosecution in Williamson #8) and petition are DENIED without prejudice to a subsequent determination granting or denying Williamson #18. Moreover, should Williamson #18 be granted in any respect, I will entertain a motion requesting that I exercise authority under 37 CFR § 1.642 to add Lemelson 07/636,415 to this interference. Under those circumstances, if Williamson #18 is granted, the relief sought in Williamson #8 and the unnumbered motion relating to involvement in the interference or suspension of prosecution will result; if it is not granted, the relief sought in Williamson #8 and the unnumbered motion is unwarranted. Likewise the request for sanctions in Williamson's unnumbered motion is DENIED. Until Williamson #18 is decided, I see no reason for considering sanctions against Lemelson on the basis asserted. If Williamson #18 is denied, the sanctions requested in Williamson's unnumbered motion will presumably be unwarranted. If it is granted in any respect, the matter of sanctions can be addressed at that time.


Williamson's petition explicitly seeks to invoke the supervisory authority of the Commissioner, under the provisions of 37 CFR § 1.644(a)(2) and (a)(3), and simultaneously seeks waiver of the second sentence of 37 CFR § 1.644(b) which provides that, "A petition under paragraph (a)(2) of this section shall

not be filed prior to the party's brief for final hearing (see § 1.656)." Summarizing, Williamson seeks to have a single person, namely me, placed in charge of watching over the ex parte prosecution of four Lemelson applications, namely 07/126,319, 07/636,415, 07/636,414 and 07/049,381, for the purpose of preventing those applications from issuing "without the most careful PTO review" (petition, p. 3). Indeed, Williamson seeks to have 07/636,415 added to the present interference immediately, or its prosecution suspended. In the event that I do not waive the second sentence of 37 CFR § 1.644(a)(2), Williamson wishes to have the matters decided under 37 CFR § 1.181(a)(3) and/or § 1.182.

The petition is DENIED in all respects. The petition is premature, as is made clear by 37 CFR § 1.644(b), second sentence. Furthermore, it is not evident that is an extraordinary situation where justice requires that 37 CFR § 1.644(b), second sentence, be suspended or waived, pursuant to 37 CFR § 1.183. Couching the petition as one under 37 CFR § 1.644 or 37 CFR § 1.181(a)(3) or 37 CFR § 1.182 does not serve to provide either a different decision maker or a different decision. Patent 4,621,410 is involved in the present interference and, for that reason alone, is clearly within my jurisdiction.

That is not to say that I will ignore the potential for other interferences involving the Lemelson applications which Williamson has identified. In order to preserve the status quo

pending decision of at least Williamson #18, I have directed the Program and Resources Administrators of the Board of Patent Appeals and Interferences ("Board") to borrow from the patent examining group, and monitor the whereabouts of, Lemelson applications 07/126,319, 07/636,415, 07/636,414 and 07/049,381. Presently, all of those applications are located in my offices at the Board. Absent direction from the Commissioner of Patents and Trademarks or other lawful order, it is ORDERED that those cases remain in my offices and under my control until such time as any relevant preliminary motions are decided. Further actions in those applications will be determined, at least in part, by the decisions on Williamson #18. Lemelson's objections to this course of action ignore my authority under 37 CFR § 1.610(e) to determine a proper course of conduct in this interference for any situation not specifically provided for.

  
\_\_\_\_\_  
BRUCE H. STONER, JR.  
Chief Administrative Patent Judge

Interference No. 103,740

cc: Attorneys for Williamson

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Paper No. 157

BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES  
(Chief Judge Bruce H. Stoner, Jr.)

DAVID T. N. WILLIAMSON  
Junior Party,<sup>1</sup>

v.

JEROME H. LEMELSON  
Senior Party.<sup>2</sup>

MAILED

JUN 23 1997

PAT. & T.M. OFFICE  
BOARD OF PATENT APPEALS  
AND INTERFERENCES

Patent Interference No. 103,740

DECISION ON RECONSIDERATION AND SCHEDULING ORDER

On Friday, June 13, 1997, at about 11:30 am (ET), and on Thursday, June 19, 1997, at about 1:30 pm (ET) conference calls were held involving the following participants:

Frank Osha, Esq., Mark Boland, Esq., Kenneth J. Burchfiel, Esq., and Brian Hannon, Esq. on behalf of Williamson;

Louis J. Hoffman, Esq. and Steven G. Lisa, Esq. on behalf of Lemelson, and

Chief Judge Bruce H. Stoner, Jr.

<sup>1</sup> Patent 4,621,410, issued November 11, 1986, based on Application 06/429,918, filed September 30, 1982.

<sup>2</sup> Application 07/126,319, filed November 10, 1987.

As I recall, Mr. Osha did not participate in the June 13th conference call, while Mr. Lisa and Mr. Hannon did not participate in the June 19th conference call.

The June 13th conference call was scheduled at the request of counsel for Lemelson with the agreement of counsel for Williamson. At my request, an agenda for that call was developed by the parties and faxed to me on June 12, 1997, by counsel for Lemelson. That agenda reads as follows:

AGENDA ISSUES

1. Lemelson's request for clarification of whether, in view of Judge Sooner's denial, without prejudice, in the June 6, 1997 ORDER (Paper No. 149) of Williamson's Rule 642 Motion (unnumbered motion filed March 5, 1997), Lemelson need not respond to Williamson Contingent Motion Nos. 29-36. The parties disagree on this issue.

2. Lemelson requests that Time Period #2 be extended as follows. Williamson does not oppose this request, provided that Time Period #3 is extended for the same additional length of time, beyond the two month period presently set for Time Period #3, and Lemelson is agreeable to such extension of Time Period #3. Accordingly, the parties are in agreement, subject to the approval of the Chief Judge, with the following revised schedule for completing preliminary motions:

(a) If Lemelson is not required to respond to Williamson Preliminary Motion Nos. 29-36, the parties agree to a two-week addition to each of Time Period Nos. 2 and 3, so that the schedule would be reset as follows:

- Time Period #2: July 11, 1997
- Time Period #3: Sept. 25, 1997
- Time Period #4: Oct. 25, 1997

(b) If Lemelson is required to respond to Williamson Preliminary Motion Nos. 29-36, the parties agree to a four-week addition to each of Time Period Nos. 2 and 3, so that the schedule would be reset as follows:



- Time Period #2: July 25, 1997
- Time Period #3: Oct. 23, 1997
- Time Period #4: Nov. 23, 1997

3. Williamson's request filed June 11, 1997, for Chief Judge Stoner to reconsider in part the June 6, 1997 Order (Paper No. 149) denying Williamson's Rule 642 Motion (unnumbered motion filed March 5, 1997). The parties disagree on this issue.

In the course of the June 13th conference call, I directed counsel for Lemelson to file an opposition to Williamson's request for reconsideration. During that conference call, counsel for Lemelson also indicated that they intended to file a request for reconsideration in part, which was made due by close of business June 16, 1997. Oppositions to both requests were made due by close of business June 18, 1997.

I have considered the points raised in Williamson's request for reconsideration<sup>3</sup> and Lemelson's request for reconsideration<sup>4</sup>, and I have considered Lemelson's opposition<sup>5</sup> and Williamson's opposition<sup>6</sup> to those requests. Williamson seeks to have me change my denial of WILLIAMSON MOTION UNDER 37 C.F.R. §§ 1.642, 1.616, and 1.635 ("Williamson unnumbered motion")<sup>7</sup>, to a deferral.

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<sup>3</sup> REQUEST FOR RECONSIDERATION UNDER 37 C.F.R. § 1.640(c), filed June 11, 1997 (Paper No. 151).

<sup>4</sup> LEMELSON'S REQUEST FOR RECONSIDERATION IN PART, filed June 16, 1997 (Paper No. 153).

<sup>5</sup> OPPOSITION TO WILLIAMSON REQUEST FOR RECONSIDERATION UNDER 37 CFR § 1.640(c), filed June 18, 1997 (Paper No. 155).

<sup>6</sup> WILLIAMSON OPPOSITION TO LEMELSON REQUEST FOR RECONSIDERATION IN PART, filed June 18, 1997 (Paper No. 156).

<sup>7</sup> Filed March 5, 1997 (Paper No. 122).

Williamson points out that, due to the arguments presented concerning claims 2 through 185 of Lemelson 07/636,415, the unnumbered motion is not dependent on the favorable disposition of Williamson Preliminary Motion No. 18 (Williamson #18)<sup>8</sup>. As counsel for Lemelson has indicated in his opposition, there is no express provision under 37 CFR § 1.640(c) for a reconsideration of a decision on motion under 37 CFR § 1.642. Neither is there express provision for a motion (as distinct from a request) under 37 CFR § 1.642. Although it is questionable as to whether a motion under 37 CFR § 1.642 is proper, *Gerk v. Cottringer*, 17 USPQ2d 1615 (Bd. Pat. App. and Int., 1990), the guidance provided by *Theeuwes v. Bogentoft*, 2 USPQ2d 1378 (Comm'r Pats. 1986), indicates that an administrative patent judge is required to at least consider a request to add an additional application to an interference once the application has been brought to his or her attention. Whether the document which brings this to the judge's attention is entitled "motion" or "request" should have no bearing on whether the request is considered. Moreover, it is appropriate for an administrative patent judge to correct an error called to his or her attention in a timely manner, no matter the caption of the document pointing out the error. I shall, therefore, sua sponte correct my designation of the disposition of the unnumbered motion from being denied to being DEFERRED. In answer to the comment by counsel for Lemelson that

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<sup>8</sup> Filed September 26, 1996 (Paper No. 59).

the claims in Lemelson 07/636,415 are subject to change, any action on the "request" or "motion" for addition will be based on what is being claimed in 07/636,415 when the evaluation is made, consonant with 37 CFR § 1.642. I am not persuaded by anything in Lemelson's request for reconsideration that my ORDER borrowing application files from the examining group is inappropriate under circumstances such as those here, where it is important that inconsistent decisions in *inter partes* and *ex parte* proceedings be avoided.

In confirmation of my ORDER orally delivered during the conference call on June 19th:

(1) Lemelson is ORDERED to refrain from filing any opposition to Williamson Contingent Preliminary Motions 29 through 36.<sup>9</sup> As I indicated to counsel for the parties, counsel for Williamson were correctly advised to file these motions when they did, in my view. Nevertheless, to avoid further burdening the already ballooning record of this interference with papers which may not be necessary should the 07/636,415 application never be added to this interference, I ORDER counsel for Lemelson to not file oppositions to Williamson Contingent Preliminary Motions 29-36 at this time. As I advised counsel for both parties during the June 19th conference call, should I exercise my discretion to add the 07/636,415 application, I plan to ORDER that Lemelson file any opposition within one week of my ORDER and

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<sup>9</sup> These motions, each of which was filed May 5, 1997, are respectively identified as Paper Nos. 139 - 146.

to ORDER that Williamson file any reply to those oppositions within one week.

During the June 19th conference call, I did not comment on LEMELSON'S RULE 635 MOTION #8 (DISMISSING WILLIAMSON'S CONTINGENT MOTIONS 29-36 AS IMPROPER UNDER THE RULES).<sup>10</sup> This motion is DENIED; Williamson is directed to file no opposition to this motion. Should I, in the exercise of my discretion, grant Williamson's request to add 07/636,415, the contingency will have occurred and Lemelson will have opportunity to oppose preliminary motions 29-36. In the meantime, Lemelson need not file any opposition to these.

(2) The time periods will be reset as agreed in part 2(a) of the "AGENDA ISSUES" quoted above, with the exception that period 4 is adjusted to expire on Monday, October 27, 1997, rather than on Saturday October 25, 1997. Thus, the following SCHEDULING ORDER is entered with the time periods previously set being reset as follows:

TIME PERIOD NO. 2

The time for filing and serving:

(1) oppositions to preliminary motions (37 CFR § 1.638(a)) and (2) preliminary motions pursuant to 37 CFR § 1.633(i) and (j) responsive to a preliminary motion filed by an opponent (37 CFR § 1.636(b)) is set to expire on JULY 11, 1997.

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<sup>10</sup> Filed June 18, 1997 (Paper No. 157).

TIME PERIOD NO. 3

The time for filing and serving:

(1) replies to oppositions (37 CFR § 1.638(b)) and (2) oppositions to preliminary motions pursuant to 37 CFR § 1.633(i) and (j) is set to expire on SEPTEMBER 25, 1997.

TIME PERIOD NO. 4

The time for filing replies to oppositions to preliminary motions pursuant to 37 CFR § 1.633(i) and (j) is set to expire on OCTOBER 27, 1997.

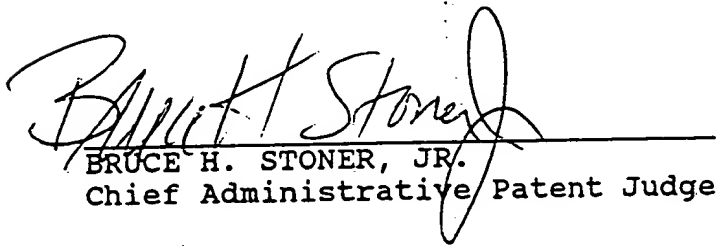
As stated in my original scheduling order, the parties are authorized to stipulate different times (earlier or later) for TIME PERIOD NO. 2, provided, a written stipulation signed by counsel for both parties, including a proposed order shall be filed with the Board as soon as practical after any agreement is reached. The parties may not stipulate an extension of TIME PERIOD NO. 3 or TIME PERIOD NO. 4.

An exhibit mentioned in preliminary motions, oppositions, replies, and affidavits shall be served (but not filed) with the preliminary motion, opposition, reply or affidavit in which the exhibit is first mentioned, and all exhibits mentioned in preliminary motions, oppositions, replies and affidavits shall be filed simultaneously in the Patent and Trademark Office on or before OCTOBER 27, 1997.

HEARING ON PRELIMINARY MOTIONS

On or before NOVEMBER 10, 1997, the parties shall file a paper indicating whether or not they desire oral argument on preliminary motions, it generally being my preference to have oral argument where there are contested preliminary motions.

A date for oral arguments on preliminary motions will likely be in the time period DECEMBER 1, 1997, through DECEMBER 12, 1997, to be set more precisely in a future order, preferably after a telephone conference call to be arranged in the future, it being my intention to decide preliminary motions within three (3) weeks of the date of any hearing.

  
BRUCE H. STONER, JR.  
Chief Administrative Patent Judge

Interference No. 103,740

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